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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,238	01/31/2004	Ronald L. Darata	03-016-RD	8170
7590 12/09/2005			EXAMINER	
Lambert & Associates Suite 200 92 State Street Boston, MA 02109			MAI, HUY KIM	
			ART UNIT	PAPER NUMBER
			2873	

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/769,238

Applicant(s)

DARATA ET AL.

Examiner

Huy K. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-93 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-71 and 78-93 is/are rejected.
7) ☒ Claim(s) 72-77 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 31 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1,2,5 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Xiao (6,505,932).

The limitations in claims 1,2,5 are shown in Xiao's Fig.1, columns 3-4. Xiao discloses a primary spectacle frame assembly comprising: an eyerim 151; a first end piece 13 and a second end piece 14 attached to and extending from a first outer side and a second outer side of said eyerim; a first rimblock 17 and a second rimblock 18, a bridge 111 attached to and connecting the inner sides of said eyerim; a first temple 112; and a second temple 113.

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3. Claims 8-13,20,23,26,27,30,32 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (5,867,244).

The limitations in claims 8-13,20,23,26,27,30,32 are shown in Martin's Figs. 1-2, columns 2-3. Martin discloses an auxiliary clip-on assembly comprising: a plurality of auxiliary clip-on lenses, a rear vertical surface; and a first and second end piece retainers 40,42.

4. Claims 8,15,16 are rejected under 35 U.S.C. 102(b) as being anticipated by Sadler (5,416,537).

The limitations in claims 8,15,16 are shown in Sadler's Figs. 1-3, columns 2-3. Sadler discloses an auxiliary clip-on assembly comprising: a plurality of auxiliary clip-on lenses 11, a rear vertical surface; and a first and second end piece retainers 17.

5. Claims 33-40,43-65 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (2001/0021001).

The limitations in claims 33-40,43-65 are shown in Lee's Figs.1,2,6-8, pages 2-3. Lee discloses an eyeglass device comprising: a primary spectacle frame assembly 100 for supporting primary lenses 101 therein, said primary spectacle frame assembly including two side portions each having an end piece extended therefrom for pivotally coupling a temple thereto, said primary spectacle frame assembly including a front portion, a rear portion, an upper portion, a lower portion, a top portion, a bottom portion and two side portions.

6. Claims 33,34,41,42 are rejected under 35 U.S.C. 102(b) as being anticipated by Huang (6,113,234).

The limitations in claims 33,34,41,42 are shown in Huang's Figs.1,2, column 2. Huang discloses an eyeglass device comprising: a primary spectacle frame assembly 10 for supporting primary

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lenses 23 therein, said primary spectacle frame assembly including two side portions each having an end piece extended therefrom for pivotally coupling a temple 11 thereto, said primary spectacle frame assembly including a front portion, a rear portion, an upper portion, a lower portion, a top portion, a bottom portion and two side portions.

Regarding claims 41,42, the frame in the auxiliary frame inherently includes a torsion bar.

7. Claim 71 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lemelson (4,217,037).

The limitations in claim 71 are shown in Lemelson's Figs.1-6, columns 2-4. Lemelson discloses an auxiliary clip-on assembly comprising: a single member lens 41 possessing a front vertical surface and a rear vertical surface; a plurality of end piece retainers 44; and a plurality of fasteners wherein said plurality of end piece retainers 44 are mounted on said rear surface of said single member lens and said fasteners are mounted on said front surface of said single member lens and wherein said fasteners couple said end piece retainers to said lens by penetrating said lens.

8. Claims 79-91 are rejected under 35 U.S.C. 102(e) as being anticipated by Ifergan (6,811,254).

The limitations in claims 79-91 are shown in Ifergan's Figs.1-22, columns 2-6. Ifergan discloses an auxiliary clip-on assembly comprising: an auxiliary frame for housing a pair of lenses; a first and a second end piece retainer, said first and said second end piece retainers each comprising a vertically disposed member attached to said auxiliary frame and a first and second horizontally disposed members attached to said vertically disposed member.

9. Claims 92,93 are rejected under 35 U.S.C. 102(b) as being anticipated by Xiao.

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The limitations in claims 92,93 are shown in Xiao's Figs.1-3, columns 3-4. Xiao discloses an eyeglass device comprising: a primary frame 10 for supporting primary lenses 121,122 therein; the primary frame including two side portions 13,14, a front portion and a rear portion; and the primary frame including a first and a second rimblock 17,18 respectively having a horizontal surface and being secured to one of said side portions of said primary spectacle frame; and an auxiliary frame 20 for supporting auxiliary lenses 201,202 therein and for disposing in front of the primary spectacle frame 10, the auxiliary frame 20 including an auxiliary rear portion, wherein the auxiliary spectacle frame further includes two end piece retainers 22,23 each secured to said auxiliary rear portions and having a horizontal surface for coupling a corresponding horizontal surface of one of said rimblocks so as to secure the auxiliary frame to the primary frame.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 3,4,6,7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Xiao.

Regarding claims 3,4 since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

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Regarding claims 6,7, the optical properties of the lenses in a pair of spectacles depend on the needs of the user such as prescription lenses or sunglass lenses which are well known and commonly use in this art. Therefore, the limitations in claims 6,7 are unpatentable over Xiao reference.

12. Claims 14,24,25,28,29,31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin.

Regarding claims 14,24,25, since one material has properties better than another material, it would have been obvious to a worker having general skill in this art to select a known material on the basis of its suitability for intended used as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claims 21,22, absence in showing the new or unobvious results and the reasons why the first and second end piece retainers affixed to the auxiliary frame by screws or adhesive means, it would have been an obvious engineering choice to select screws or adhesive means to affix the first and second end piece retainers to the auxiliary frame.

Regarding claims 28,29,31, although Martin device does not teach the shape and size of the auxiliary clip-on assembly being different from those of the primary spectacle frame as that claimed by applicant, the shape, size, dimension differences are considered obvious choices and are not patentable unless unexpected results are obtained from these changes. Therefore, it would have been obvious to a person having ordinary skill in this art to modify the Martin reference by forming an auxiliary clip-on assembly being different from the primary spectacle frame in shape and size. Such a modification would have no functional differences from the Martin reference.

13. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadler.

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Absence in showing the new or unobvious results and the reasons why the first and second end piece retainers affixed to the auxiliary frame by screws or adhesive means, it would have been an obvious engineering choice to select screws or adhesive means to affix the first and second end piece retainers to the auxiliary frame.

14. Claims 66-70 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huang.

It should be noted that although claims 66-70 “method claims”, the method steps consist of the broad steps of “attaching”, “applying” and “attaching” and therefore these steps would be inherently satisfied by the apparatus of the reference.

15. Claim 78 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lemelson.

The optical properties of the lenses in a pair of spectacles depend on the needs of the user such as polarized lenses which are well known and commonly use in this art. Therefore, the limitations in claim 78 are unpatentable over Lemelson reference.

Allowable Subject Matter

16. Claim 72 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Claims 73-77 are objected to as being dependent upon the above objected claim.

Response to Arguments

18. Applicant's arguments filed Jul. 19, 2005 have been fully considered but they are not persuasive. The applicant argues in page 23 that “The primary spectacle frame of the present invention must only be constructed such that the primary spectacle frame includes end pieces 4 and eyerims 2 for attachment with the auxiliary slip-on assembly. The present invention is

clearly distinguished from Xiao.” It appears that the applicant argues the features that are not claimed in claim 1.

19. Similarly, the applicant argues in pages 23-24 that “On the other hand, with respect to the present invention, the present invention does not rely on outdated means such as clips to secure the primary and auxiliary frames. Further, Martin is contradictory. The patent both indicates engagement “without the need for tensioning” and yet references a “third tensioning clip””. The applicant argues the features that are not claimed in claims 8,33,66,69-71,79,92.

20. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

21. The objection to drawings and the rejection to claims 79-91 under 35 USC 112, first paragraph, have been withdrawn because of Fig. 7a. The rejection to claims 8,16-19,26-32,34,46-49,53-56;66,68-70,81-84, and 87-92 under 35 USC 112, second paragraph, have been withdrawn.

NOTE: The examiner appreciates the applicant in telephone communication to verify the correct reference Ifergan (6,811,254) in the Office action.

Conclusion

22. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Mai whose telephone number is (571) 272-2334. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky L. Mack can be reached on (571) 272-2333. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562.



Huy Mai
Primary Examiner
Art Unit 2873

HKM/
December 7, 2005